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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213350
Party	Defendant Kim, Yunja
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Date	01/15/2014
Attachments	Answer to Notice of Opposition.pdf(227570 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Tricot Saint-James,)	
)	
Opposer,)	
)	Opposition No. 91213350
v.)	Mark: JAMES
)	Application No. 78/656,504
Kim, Yunja)	
)	
Applicant.)	

ANSWER TO NOTICE OF OPPOSITION

Applicant, Yunja Kim, by and through her attorneys, hereby answers the Notice of Opposition of Tricot Saint-James, as follows:

1. *Commencing long prior to Applicant's filing date and prior to any priority date that can be alleged by Applicant, Opposer has used, and Opposer is now using, the mark "SAINT JAMES" in connection with the sale, advertising and promotion of various goods, including in particular clothing such as jackets, cardigans, dresses, skirts, slacks, sweaters, sweat-shirts, t-shirts, blouses, overblouses, jumpers, long underpants, pedal pushers, Bermuda shorts, caps, scarves, socks, gloves, among others, covered under International Class 25, distributed and sold by Opposer in commerce.*

ANSWER: Applicant lacks the knowledge or information sufficient to form a belief as to the truth or falsity as to the allegations of Paragraph 1.

2. *Opposer is owner of, and will rely herein, upon the Federal Registration No. 2,361,110 for the mark "SAINT JAMES" granted in International Class 25. This registered mark is valid, subsisting, and provide prima facie evidence of Opposer's ownership of its mark "SAINT JAMES", of the validity of said mark, and of Opposer's exclusive right to use the mark in commerce for the goods specified in said registrations.*

ANSWER: Applicant admits Opposer is the listed owner of the Registration No.

2,361,110 for SAINT JAMES. Applicant lacks the knowledge or information sufficient to form a belief as to the truth or falsity as to the remaining allegations of Paragraph 2.

3. *Opposer has extensive common law rights in the mark "SAINT JAMES" in connection with various goods including clothing articles covered under International Class 25.*

ANSWER: Applicant lacks the knowledge or information sufficient to form a belief as to the truth or falsity as to the allegations of Paragraph 3.

4. *Since the initial adoption and use of Opposer's mark "SAINT JAMES" Opposer has engaged in extensive advertising and generated significant sales of its goods under said mark.*

ANSWER: Applicant lacks the knowledge or information sufficient to form a belief as to the truth or falsity as to the allegations of Paragraph 4.

5. *By virtue of the aforesaid extensive use, advertising, sale and promotion, consumers have come to recognize and associate Opposer's mark "SAINT JAMES" with Opposer and its goods and services. As a result, Opposer has acquired substantial and valuable goodwill in the mark "SAINT JAMES" and the mark has become a distinctive indicator of the origin of Opposer's goods long prior to the filing date of the opposed application, and prior to any priority date that can be alleged by Applicant.*

ANSWER: Applicant lacks the knowledge or information sufficient to form a belief as to the truth or falsity as to the allegations of Paragraph 5.

6. *Notwithstanding Opposer's prior established rights in the marks "SAINT JAMES," Applicant has filed Application No. 78656504 with the United States Patent and Trademark Office on July 23, 2012 for "clothing, namely, denim jeans, pants, sweaters, coats, jackets, dresses, blouses, shirts, shorts, cardigans and skirts" in International Class 25, as evidenced by the publication of said mark in the Official Gazette of the July 9, 2013 issue.*

ANSWER: Applicant admits to have filed Application No. 78656504 with the United States Patent and Trademark Office for "clothing, namely, denim jeans, pants, sweaters, coats, jackets, dresses, blouses, shirts, shorts, cardigans and skirts," in International Class 25, and admits that the mark was published in the July 9, 2013 issue of the Official Gazette, and denies the remaining allegations of Paragraph 6.

7. *Applicant's application to register the mark "JAMES" is without Opposer's consent or permission.*

ANSWER: Admit.

8. *There is no issue as to priority. The filing date of Applicant's mark and any priority date that could be alleged by Applicant are subsequent to the first use date of Opposer's mark "SAINT JAMES," and subsequent to the introduction and use of Opposer's mark "SAINT JAMES" to the marketplace and the purchasing public.*

ANSWER: Applicant lacks the knowledge or information sufficient to form a belief as to the truth or falsity as to the allegations of Paragraph 8.

9. *The mark "JAMES" that Applicant seeks to register so closely resembles Opposer's mark "SAINT JAMES" in appearance, sound, and meaning that the use and registration thereof is likely to create the same overall impression on consumers and to cause confusion, mistake, and deception as to the source or origin of Applicant's services and will injure and damage Opposer and the goodwill and reputation symbolized by its mark "SAINT JAMES."*

ANSWER: Denied.

10. *Applicant's goods are identical or so closely related to Opposer's goods that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Opposer, or that Applicant is in some way connected or affiliated with, or sponsored by Opposer, all to Opposer's irreparable damage.*

ANSWER: Denied.

11. *Likelihood of confusion in this case is enhanced by the fact that consumers associate the mark "SAINT JAMES" with goods sold, approved, or endorsed by Opposer; furthermore, purchasers of Applicant's goods are prospective purchasers of Opposer's goods, and vice versa.*

ANSWER: Applicant lacks the knowledge or information sufficient to form a belief as to the truth or falsity as to the allegations of Paragraph 11.

12. *Applicant's mark "JAMES" will be marketed and sold to the same consumers and through the same trade channels than Opposer's "SAINT JAMES" mark, therefore, it is likely to cause confusion or mistake, or to deceive, within the meaning of Section § 2(a) of the Trademark Act.*

ANSWER: Denied.

13. *Applicant's mark "JAMES" so closely resembles Opposer's "SAINT JAMES" mark that it is deceptive in that it falsely suggests a connection with or approval by Opposer, in violation of Section §2(a) of the Trademark Act. Indeed, Applicant's mark points uniquely to Opposer, and purchasers will assume that clothing offered under Applicant's alleged mark are connected with or approved by Opposer.*

ANSWER: Denied.

14. *If Applicant is permitted to use and register its mark for the goods covered by the opposed application, confusion resulting in damage and injury to Opposer will likely occur.*

ANSWER: Denied.

15. *If Applicant were granted the registration herein opposed it would thereby obtain at least a prima facie exclusive right to its mark and the use thereof. Such registration will be a source of damage and injury to the Opposer.*

ANSWER: Denied.

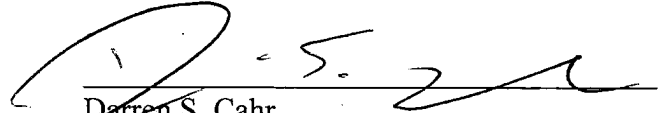
AFFIRMATIVE DEFENSES

1. Opposer's claim is barred by laches, waiver and/or estoppel.
2. Opposer's claim is barred by the principle of acquiescence.

WHEREFORE, Applicant prays that the subject Opposition be denied and that Applicant's mark be registered.

Respectfully submitted,

YUNJA KIM

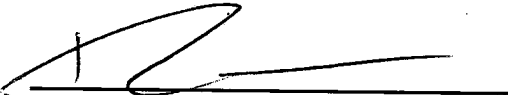


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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER TO NOTICE OF OPPOSITION has been served on the Attorney of Record for Opposer, by mailing said copy on January 15, 2014, via First Class Mail, postage prepaid to:

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